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IN THE

Supreme Court of the United States

October Term, 1952

No. 155

THE ESTATE STOVE COMPANY and NOMA ELECTRIC CORPORATION (a Maryland Corporation), and NOMA ELECTRIC CORPORATION (a New York Corporation),

Petitioners,

—v.—

GENERAL MOTORS CORPORATION and GENERAL MOTORS SALES CORPORATION,

Respondents.

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

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THE ESTATE STOVE COMPANY and NOMA ELECTRIC CORPORATION (a Maryland Corporation), and NOMA ELECTRIC CORPORATION (a New York Corporation),

Petitioners,

—v.—

GENERAL MOTORS CORPORATION and GENERAL MOTORS SALES CORPORATION,

Respondents.

PETITION FOR WRIT OF CERTIORARI

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, The Estate Stove Company and Noma Electric Corporation (a Maryland Corporation) and Noma Electric Corporation (a New York Corporation), respectfully pray that a Writ of Certiorari issue to review the judgment, entered January 13, 1953* (R. Vol. IV, p. 1) of the United States Court of Appeals for the Sixth Circuit in which petitioners were plaintiffs-appellees.

A certified transcript of the Record in the case including the proceedings in the Court of Appeals for the Sixth Circuit is furnished herewith in compliance with Rule 38 of this Court.

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* Petition for Rehearing was denied by the Sixth Circuit Court of Appeals on April 17, 1953 (R. Vol. IV, p. 85).

Summary Statement of Matter Involved

Petitioners sued Respondents in the United States District Court for the Southern District of Ohio, Western Division for infringement of certain patents relating to electric cooking stoves. The District Court held valid and infringed all the claims involved in this Petition and issued the usual injunction. The Respondents under the necessity of continuing to manufacture the infringing ranges pending final outcome on appeal posted a supersedeas bond in the sum of $750,000. The Court of Appeals for the Sixth Circuit reversed and held "the patent claims sued upon are invalid for want of invention."* In so holding the Court applied the severe test of invention laid down by this Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84 and *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147.

On January 1, 1953 the Patent Act of 1952 came into effect (Title 35 of United States Code, Public Law 593, 82nd Congress, 2nd Session, Chap. 950, 66 Stat. 792, approved July 19, 1952). The decision of the Court of Appeals was rendered on January 13, 1953, twelve days after the new Patent Act took effect. The Petitioners on February 2, 1953 filed a Petition for Rehearing (R. Vol. IV, p. 39) calling this Patent Act of 1952 to the attention of the Court of Appeals and in particular to Section 103 thereof more fully hereinafter discussed. This section was made the basis for the claim by Petitioners that an incorrect test of invention had been applied by the Court. The Court recognized that it had not taken the new Patent Act into

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* The Court of Appeals did not pass on the issue of infringement thus leaving the Findings of Fact as to infringement undisturbed.

consideration but nevertheless denied the Petition for Rehearing saying:

> "We are, however, of the view that the principle stated in the *Great Atlantic & Pacific Tea Co.* case is not modified by the new Act, but continues to be the law, and is here controlling" (R. Vol. IV, p. 93).

The Court of Appeals also held that the new Act did not apply to this case.

Basically this Petition presents for consideration by this Court whether or not the recent passage of the Patent Act of 1952 is a declaration of public policy in respect to patents requiring revision of the attitude of the courts toward patents as reflected in the *Cuno Engineering* and *Great A. & P.* cases.

This, and the issue of whether or not the Patent Act of 1952 applies to an infringement suit tried under the old patent statutes and decided on appeal after the new Act took effect, present two important questions of federal law which have not been, but should be, settled by this Court.

The pertinent portions of the Patent Act of 1952 are § 103 and § 282 of Section 1 and Section 4(a).*

Jurisdiction of this Court

Jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of June 25, 1948 effective September 1, 1948 [28 U. S. C. Section 1254(1)].

The judgment of the United States Court of Appeals for the Sixth Circuit which Petitioners seek to have reviewed

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* The pertinent sections of the new Patent Act are fully set forth in the appendix where they are given together with their revision notes as set forth in House Report No. 1923, May 12, 1952.

was entered on January 13, 1953 (R. Vol. IV, p. 1). A timely Petition for Rehearing (R. Vol. IV, p. 39) was denied on April 17, 1953 (R. Vol. IV, p. 85).

The Questions Presented

1. Whether the Patent Act of 1952 has repudiated the "flash of genius" standard of invention.

2. Whether the Sixth Circuit Court of Appeals applied the proper test of invention to the patents in suit in view of the Patent Act of 1952.

3. Whether the Patent Act of 1952 applies to this case, namely, one which was tried under the old patent statutes but decided by the Court of Appeals after the old patent statutes were repealed and the new Patent Act of 1952 took effect.

4. Whether the Patent Act of 1952 precludes courts from substituting their own subjective judgment for the objective test, *i.e.*, one *based upon the evidence*, as to whether or not a new combination of old elements was obvious to one skilled in the art.

Ancillary to the foregoing broad questions are the following:

5. Whether claims 1, 11, 14 and 24 Patent No. 2,055,246 are valid.

6. Whether claims 2 through 6 inclusive of Patent No. 2,079,618 are valid.

7. Whether claims 4, 5, 6 and 9 of Patent No. 2,123,699 are valid.

Reasons Relied on for Allowance of the Writ

1. The Court of Appeals for the Sixth Circuit has failed to give effect to the annulment of the severe test of invention commonly called the "flash of genius" doctrine and the more liberal policy toward patents legislated by Congress through enactment of the Patent Act of 1952.

2. The Court of Appeals for the Sixth Circuit has substituted for the *objective* test, now mandatory upon the Courts and applied by the District Court in finding patentable invention in all of the claims, a *subjective* test leading to reversal of such finding in the absence of obvious error.

Prayer

Wherefore, your Petitioners respectfully pray that a Writ of Certiorari be issued to the Court of Appeals for the Sixth Circuit to the end that this cause may be reviewed and determined by this Court and that your Petitioners may have such other and further relief in the premises as to this Court may seem meet and just.

MORRIS KIRSCHSTEIN
Counsel for Petitioners

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Petitioners,

—v.—

GENERAL MOTORS CORPORATION and GENERAL MOTORS SALES CORPORATION,

Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The opinions of the United States District Court for the Southern District of Ohio, Western Division, are reported in 79 F. Supp. 765 and 92 F. Supp. 293.* The opinion of the Court of Appeals for the Sixth Circuit is reported in 201 F. (2d) 645. The opinion of the Court of Appeals for the Sixth Circuit denying the Petition for Rehearing is reported in 203 F. (2d) 912.

* The first of the District Court's two opinions deals with validity, the second with infringement.

Statement of the Case

The patents involved are Bradbury No. 2,055,246 and two Kahn & Hake patents Nos. 2,079,618 and 2,123,699 (R. Vol. IV, pp. 1-24). These patents relate to electric ranges and are particularly concerned with solving the housewife's cooking problems. The solution they have afforded is so ingenious and practical that the largest manufacturers of electric ranges, such as Westinghouse, General Electric and General Motors (one of the respondents herein), incorporate in their ranges the principle and construction described and covered by the patents.

In oven cooking heat is transferred to food in three different ways—by radiation, convection and conduction. Food is cooked in an oven by broiling or baking. Food is broiled by raising the surface of the food to a high temperature in order to cook the surface without cooking the interior. This is done principally by radiation which provides heat energy at the surface of the food at a high temperature without heating the inside of the food. On the other hand, in baking it is necessary to cook the food through and through. This is accomplished principally by convection and conduction.

If the oven heaters were maintained at the required high broiling temperature during baking, the outside of the food would be charred before the interior was cooked. Hence, for baking it is necessary to maintain the oven heaters at a considerably lower temperature than for broiling.

There are many complicating factors. When food is baked, in addition to being cooked through, the outside of the food should be browned. These two different processes must reach completion at the same time. Also, the food being baked should be baked uniformly, all different kinds of food must be cooked in the same oven, different types of

utensils are used to hold the food, and different shapes of food are cooked.

Prior to the advent of the Bradbury invention in 1928, no cooking range making simple provision for *all* these factors and operable with great certainty and ease by the housewife had been developed. The best the prior art had done to solve this difficult and complex problem was to provide thermostatically controlled ovens with a large number of switch positions so as to afford a great range of heat inputs to the oven, erroneously believed necessary for baking different kinds of food. As an example, a housewife with one of the admittedly best prior art ranges had to contend with no less than fifteen switch positions plus a large number of further variations occasioned by different thermostatic settings in each position.

Bradbury's invention made it possible for the housewife with one simple manipulation of simple controls to provide the heat input to the oven required for baking.

Bradbury combined a plurality of admittedly old elements (heaters, switches and thermostats) in such fashion as to create and maintain within the oven a high temperature, uniform ("balanced") baking heat which enabled the housewife to properly bake any kind of food at one switch position by simply setting the thermostat. This was an unexpected and new result which was not merely the sum of the functions of the original old elements Bradbury combined. What he did was to provide principally: (1) a lower and an upper heating unit in the oven both liberating heat at a baking rather than a broiling temperature, with the lower unit of higher calorific capacity than the upper in order thereby to obtain the "balanced" baking heat; (2) a switch to energize both units together at full baking capacity; and (3) a thermostat to intermittently turn both units on and off together to make possible the maintenance of a *high* baking heat over a wide range of temperatures.

The prior art patents and ranges employing here and there one or another element of the Bradbury patent did not in any single patent or range integrate or combine the elements in Bradbury's novel way to produce Bradbury's unexpected result.

The Kahn and Hake patents are for unusually complicated structures (R. Vol. IV, p. 29). They relate to practical improvements which enable a more efficient carrying out of the basic Bradbury concept.

The patents in suit deal with highly scientific subject matter familiar only to trained mechanical and electrical engineers and involve complex structures and complicated electric circuits. They are by no means "gadget" patents.

Specification of Errors

The errors which Petitioners will urge if this Writ of Certiorari is issued are that the Court of Appeals for the Sixth Circuit erred in reversing the District Court's decision and in holding

1. That claims 1, 11, 14 and 24 of Patent No. 2,055,246 are invalid for want of invention.
2. That claims 2 through 6 inclusive of Patent No. 2,079,618 are invalid for want of invention.
3. That claims 4, 5, 6 and 9 of Patent No. 2,123,699 are invalid for want of invention.

ARGUMENT

By Repeal of the Old Patent Statutes and Enactment of the Patent Act of 1952, Congress Decreed a Retreat from the "Flash of Genius" Doctrine and the Severe Test of Invention Applied in Recent Years by the Courts.

The Court of Appeals admitted that the combinations of the patent claims in suit were new and that the patent in suit filled a long felt want.

> "* * * It is true that in the combination, they [the components of the Bradbury patent] add greatly to the convenience of the user of the electric range compared to what had been the case prior thereto. As an instance, either broiling or baking could now be carried on in the same oven. One knob controlling baking and broiling operations, and a predetermined constant temperature, resulted in a considerable advantage, from the standpoint of convenience, over the use of two knobs for these various functions. Further, the fact that, at the baking position on the single knob, a fixed temperature of top and bottom heaters was obtained, with less heat from the top than from the bottom—which, as a result of experiment, was found to give what was claimed to be substantially even distribution of heat in the oven—for high temperature baking, was of great help to the user of an electric range, simplifying the cooking operations, and enabling them to be carried on at constant high temperature. * * *"
> (Material in brackets supplied.) Original Opinion (R. Vol. IV, pp. 26-7.)

> "It can not be denied, as we have already observed in the opinion in this case, that the patents in suit re-

sulted in a considerable advantage, from the standpoint of convenience, over what had gone before, and were of great help to the user of an electric range, in simplifying the cooking operations and enabling them to be carried on at constant high temperature. Moreover, it can be said that the Bradbury electric range may have filled a long-felt want, and enjoyed commercial success. * * * " Opinion on Rehearing (R. Vol. IV, p. 93.)

The Court of Appeals refused, however, to recognize that by enactment of the new Patent Act Congress rejected the severe test of invention laid down by this Court in the *Great A. & P.* and *Cuno Engineering* cases.

For over a hundred years the Federal Courts giving effect to the purpose of Article I, Section 8 of the Constitution to foster and protect inventions took a liberal attitude toward patents. Since the early thirties, the Courts have taken a less benevolent attitude which culminated in the severe "flash of genius" test enunciated in the *Cuno Engineering* case. Finally the *coup de grâce* was dealt to inventors by the devastating concurring opinion in the *Great Atlantic & Pacific Tea Co.* case which went even beyond the "flash of genius" doctrine and required that an invention to be patentable must "push back the frontiers of chemistry, physics and the like; to make a distinctive contribution to scientific knowledge" (340 U. S. 147, 154).

When the "flash of genius" doctrine was first enunciated it created quite a stir for it removed all objective tests of invention and replaced them by a subjective test "baffling in its uncertainty" and which, as stated by the Seventh Circuit Court of Appeals would "exclude the larger portion of those whose products have heretofore been understood as the work of an inventor." (*Chicago Steel Foun-*

dry Co. v. *Burnside Steel Foundry Co.*, 132 F. (2d) 812, 817.)

For years the Federal Courts have struggled with this new and severe test of invention and no less a jurist than Learned Hand in his dissenting opinion in *Jungersen* v. *Baden et al.*, 166 F. (2d) 807, 812 said:

> "* * * I confess myself baffled to know how to proceed, if we are at once to profess to apply the system as it is, and yet in every concrete instance we are to decide as though it did not exist as it is. In the case at bar, I can only say that, so far as I have been able to comprehend those factors which have been held to determine invention, and to which at least lip service continues to be paid, the combination in suit has every hall-mark of a valid patent."

Time and time again the Courts, faced with inventions which in the more liberal era were clearly patentable, referred to the severe test laid down by this Court, to the reversals they experienced when patents were held valid by them, and reluctantly invalidated patent after patent from sheer necessity to conform saying, as did the Court of Appeals for the Second Circuit in the *Jungersen* case, "We should heed the admonition of these reversals" (p. 811).

In this highest Court too the revolt against the severe test of invention began to stir when Mr. Justice Jackson in his dissenting opinion in *Jungersen* v. *Baden et al.*, 335 U. S. 560 at page 572, said:

> "But I doubt that the remedy for such Patent Office passion for granting patents is an equally strong passion in this court for striking them down so that the only patent that is valid is one which this court has not been able to get its hands on."

In recent years hardly a patent has survived the severe test of invention and the patent mortality rate has risen to such proportions that all incentive to invent is disappearing. Inventors whose efforts had been rewarded by the granting of a patent found when they came into court to enforce them that they had gotten from the Government nothing more than a mere scrap of paper. Our patent system which had triggered the tremendous industrial advances and progress in this country, that has made it so economically strong, fell into disrepute. The Courts groaning under the burden of the severe test of invention, contrary to the purpose of the Constitution discouraged rather than encouraged inventors. Committees and groups such as the American Bar Association and the various Patent Law Associations throughout the country took up the cudgels in behalf of the patent system.

After repeated efforts in behalf of the public, Congress finally enacted the Patent Act of 1952. It contains provisions specifically directed to the criterion of invention. Reference is made particularly to Section 103. The last sentence of this section reads as follows:

> "Patentability shall not be negatived by the manner in which the invention was made."

House Report No. 1923 is the report (May 12, 1952) by the Committee on the Judiciary of the House of Representatives explaining the Bill (H. R. 7794) which as passed constitutes the Patent Act of 1952. Senate Report No. 1979 is the report (June 27, 1952) by the Committee on the Judiciary of the Senate and is substantially the same as the House report. Pages 11-31 of the House report are "Revision Notes." As to this last sentence of Section 103 the revision note is as follows:

> "The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius."

This expresses the clear intent of Congress to remove the discouraging impediments to invention which had resulted from the severe test of invention applied by the courts and to return to the more liberal attitude and more favorable climate of opinion in the courts that existed prior to the *Cuno Engineering* decision.

To make its purpose doubly clear Congress for the first time added a provision (§282) which had never had statutory expression: "A patent shall be presumed valid"; Section 282 further provides that:

> "The burden of establishing invalidity of a patent shall rest on a party asserting it."

And the same section, subdivision (2), recites among the grounds for invalidity "any ground specified in Part II" which includes §103.

The Court of Appeals for the Sixth Circuit construed §103 as being no more than a restatement of the test as to "obviousness" applied prior to the enactment of the Patent Act of 1952. If, indeed, this section produced no change at all, why did Congress enact it and why did it specifically state that patentability shall not be negatived by the manner in which the invention is made? It was obviously a declaration by Congress of public policy annulling the "flash of genius" test for any and all patents including unexpired patents granted prior to the time of taking effect (January 1, 1953) of the new Act [Section 4(a)].

In still adhering to the severe test of invention in the *Cuno Engineering* and *Great A. & P.* cases, the Court of

Appeals for the Sixth Circuit decided contrary to this public policy.

As to the test of obviousness the first sentence of Section 103 reads as follows:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." (Italics supplied.)

The revision note for this section is:

> "There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.
>
> The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius."

The Court of Appeals for the Sixth Circuit construed §103 to have "done no more in this respect than to adopt the test of so-called 'obviousness' which has, in the past, been enunciated by the courts, and that it did not provide

a new test differing from that which has been generally followed in the adjudication of patent cases" (R. Vol. IV, p. 89).

It is Petitioners' contention here that in enacting §103 Congress admonished the courts to return to the more liberal attitude toward patents and declared this to be the public policy. This is borne out by the revision note that Section 103 should have a stabilizing effect. What better stabilization could be had than to withdraw from the indefiniteness of a subjective "flash of genius" test and from a subjective concept of the skilled mechanic to the objective tests which this high Court had in the more liberal period set as guideposts.

In this period, invalidating a patent piecemeal by subjective inference from the presence here and there of separate elements of a combination in a number of prior devices was condemned as a basis for defeating a patent for a combination. By specifically providing in Section 103 "that the subject matter *as a whole* would have been obvious," Congress has thus decreed a return to the numerous decisions of this Court and the Courts of Appeal, such as *Parks* v. *Booth*, 102 U. S. 96, where the prior art was held not to anticipate because it did not describe "the same combination in its entirety nor the same mode of operation" (p. 103), and *Imperial Bottle Cap & Machine Co.* v. *Crown Cork & Seal Co.*, 139 F. (2d) 312, 320, where the Fourth Circuit Court of Appeals held a "finding in the old devices, one portion here, one in another, and so on, should not defeat a patent for the combination, which is only truly anticipated by a prior device having identically the same elements, or their mechanical equivalents, cooperating to produce the same results." See also *Wicke* v. *Ostrum*, 103 U. S. 461, 469; *Webster Loom Co.* v. *Higgins*, 105 U. S. 580, 591; *Topliff* v. *Topliff*, 145 U. S. 156, 161;

Hookless Fastener Co. v. *G. E. Prentice Mfg. Co.*, 68 F. (2d) 940, 941 (C. A. 2); *Gray* v. *Eastman Kodak Co.*, 67 F. (2d) 190, 193-6 (C. A. 3)*; *Black & Decker Mfg. Co.* v. *Baltimore Truck Tire Serv. Corp.*, 40 F. (2d) 910, 913 (C. A. 4); *Bingham Co.* v. *Ware*, 46 F. (2d) 33 (C. A. 6); *Lavigne Mfg. Co.* v. *John F. McCanna Co.*, 194 F. 112, 113 (C. A. 7); *Dow Chemical Co.* v. *Williams Bros. Well Treating Corp.*, 81 F. (2d) 495, 500-501 (C. A. 10).

Other criteria of patentable invention, all present here, and to which Congress in the new Act bids the Courts return, are the following:

(a) That the new combination of old elements filled a long-felt need.

(b) The history test—looking at the situation before and after the inventor's contribution to the art—a test which this Court has approved, both prior and subsequent to the *Cuno Engineering* case.**

The return to all of these criteria are part and parcel of the stabilization contemplated by Congress by substituting the objective for the subjective test of invention. The new Patent Act decrees the return to reliance upon fact rather than mere inference. It has been said that the question of invention is a mixed one of fact and law. The concurring opinion in the *Great A. & P.* case removed the fact portion completely from the mixture (340 U. S. 147, 155). Congress has not only restored the fact ingredient, but has now weighted it very heavily.

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* Reversed on technical procedural grounds, 292 U. S. 332.

** *Grover Tank & Mfg. Co. Inc. et al.* v. *Linde Air Products Co.*, 336 U. S. 271;
Goodyear Tire & Rubber Co. Inc. et al. v. *Ray-O-Vac Co.*, 321 U. S. 275;
Eibel Process Co. v. *Minnesota & Ontario Paper Co.*, 261 U. S. 45.
Hildreth v. *Mastoras*, 257 U. S. 27;

The Courts are now admonished to make the objective test supreme and to apply the rigors of Rule 52(a)* of the Federal Rules of Procedure to the finding of invention as a fact.

By specifically placing the burden of establishing invalidity for lack of invention for obviousness upon the party asserting it (§282) and simultaneously for the first time giving statutory expression to the *prima facie* validity of patents, Congress through the new Patent Act reasserted and emphasized the requirement supported by generations of authority that the defendant in a patent suit must establish *by evidence* that the invention was obvious. The record here not only lacks any such evidence but to the contrary is replete with positive evidence of non-obviousnss. It is not necessary to point to the evidence here in detail. It was called to the lower Court's attention (R. Vol. IV, pp. 56-57). That Court did not gainsay the proof. It adhered to the theory that the subjective test still applied (R. Vol. IV, p. 89).

Petitioners do not mean to suggest that the issue of "obviousness" is not affected by the great advance in technical skill and in the industrial arts as compared with the earlier days of this republic. The difficulty that arose in this connection and which now must be remedied is that the Courts in their zeal to increase the standard of invention in the light of such progress have forgotten that it is the condition as it existed "at the time the invention was made" (§103) that must be taken into account. Mr. Justice Frankfurter in his dissent in *Marconi Wireless Telegraph Co.* v. *United States,* 320 U. S. 1, recognized this difficulty when he said:

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* "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

"Above all, judges must avoid the subtle temptation of taking scientific phenomena out of their contemporaneous setting and reading them with a retrospective eye.

* * * * *

The real question is how significant a jump is the new disclosure from the old knowledge. Reconstruction by hindsight, making obvious something that was not at all obvious to superior minds until someone pointed it out,—this is too often a tempting exercise for astute minds. The result is to remove the opportunity of obtaining what Congress has seen fit to make available" (p. 62).

Here in this very case the Court of Appeals for the Sixth Circuit when it said "but these circumstances (the filling of a long-felt want, etc.) are not enough to warrant a finding of invention under the 'severe' test applicable in the present day of rapid advance in the art" (R. Vol. IV, p. 93) wholly lost sight of the fact that the Bradbury invention was made in 1928, a quarter of a century before that Court decided the case.

Against the background of a liberalized policy toward invention and with the year 1928 and not 1953 as the chronological point against which to measure "obviousness," the patents here involved constituted patentable invention as found objectively from the facts by the District Court.

The Sixth Circuit Court of Appeals Erroneously Held That the Patent Act of 1952 Was Not Applicable to the Case at Bar

The lower Court not only rejected the proposition that the Patent Act of 1952 changed the standard of invention from a subjective one to an objective standard but held further that the new Act did not apply to this case. This Petition thus presents an important question as yet undecided by this Court as to whether the new Patent Act applies to a patent suit tried under the old patent statutes and decided by a Court of Appeals after the new Act took effect. The importance of this question will be at once obvious. It is Petitioners' contention that the answer to this question is in the affirmative and that the Sixth Circuit Court of Appeals was in error.

The principle that a statute must be so construed as to effect the purpose for which it has been enacted is too familiar to require citation of cases. If, as is above contended, the new Patent Act is a declaration of public policy in repudiation of the severe test of invention, then that purpose is to be given effect. Congress made sure of that by specifically providing that the new Act shall take effect on January 1, 1953 and "shall apply to unexpired patents granted prior to such date except as otherwise provided." The exceptions are enumerated in sub-divisions (b) to (h), inclusive, of Section 4, none of which apply to this case.

The Court of Appeals for the Sixth Circuit held the new Act did not apply and relied on Section 5 as an exception to Section 4(a) which provides that the new Act shall apply to unexpired patents granted prior to January 1, 1953, the effective date, "except as otherwise provided." Section 5 reads as follows:

> "The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following

schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal."

Obviously this section is the usual "saving" clause to prevent the new Act from being confiscatory of any property rights contrary to the due process provision of the Constitution. Thus, the causes of action for infringement occurring prior to the effective date of the new Act are preserved, as one obvious example of the clear effect of this saving clause. But the right to rely upon a judge-made criterion of invention is not a property right of the character preserved by provision against confiscation. The criterion of invention may change from time to time as it is merely a matter of judicial construction. There is no constitutional guarantee against a change in climate of opinion. No one could be heard to claim confiscation if even before enactment of the new Act a court decided on its own to relax the standard of invention in a particular case. It is to be noted that the defense of want of invention is specifically preserved in the new Patent Act by a special provision, namely, § 282(2). The question of whether the saving Section 5 of the new Act applies to the existing criterion of invention prior to January 1, 1953 is of great public importance. One other Court of Appeals, that of the Fifth Circuit, has held that it does, and the Court of Appeals for the Sixth Circuit here merely followed the decision of the Fifth Circuit of Appeals in *Texas-Miller Hat Corp.* v. *Switzer Bros., Inc.*, 201 F. (2d) 824. It is urged that the Fifth Circuit Court of Appeals incorrectly decided this issue and that this Court should correct such erroneous construction of Section 5 of the new Act so to settle the matter once and for all for all the Federal courts.

Summary

The Patent Act of 1952 does apply to this case.

The repeal of the old patent statutes and enactment of the Patent Act of 1952 was a declaration by Congress of a new public policy to alleviate the emasculating effects on our patent system of the severe test of invention applied in recent years by this Court. Congress has repudiated the "flash of genius" doctrine of the *Cuno Engineering* case and the even more severe test of the *Great A & P* case. By enacting §103 of the new Act it was the purpose and intent of Congress to "minimize the great departures which have appeared in some cases." *

The Court of Appeals for the Sixth Circuit erred not only in holding that the Patent Act of 1952 did not apply, but also in failing to construe the Act to give effect to the legislative intent.

The Court of Appeals for the Sixth Circuit here has erroneously held that § 103 is merely declaratory of what the law had been and therefore felt free to substitute its own judgment for the judgment of the District Court and to reverse the findings of that court that patentable invention was present in the patents in suit.

§ 103 provides that a patent may not be obtained "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." By employing the words "as a whole" Congress specifically intended to pre-

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* From the Report of the Committee on the Judiciary, May 12, 1952, concerning revision of Title 35, United States Code, under the heading "General Description of Bill," 23rd paragraph.

clude a subjective finding of obviousness based upon a mosaic built by a court from elements found here and there in separate patents or publications in the prior art.

CONCLUSION

The questions presented in this petition arise under the new Patent Act of 1952 which took effect on January 1, 1953. These questions have never been passed upon by this Court and involve vital issues in regard to the standard of invention and applicability of the new Patent Act of 1952 to cases tried under the old patent statutes and decided on appeal after their repeal. It is respectfully urged that the petition should be granted.

Respectfully submitted,

MORRIS KIRSCHSTEIN
Counsel for Petitioners

APPENDIX

Excerpts from Patent Act of 1952 with Revision Notes

Sec. 1

* * * * *

§ 103. **Conditions for patentability; non-obvious subject matter**

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

SECTION 103—NEW SECTION

There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius.

* * * * *

§ 282. **Presumption of validity; defenses**

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity of infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement, or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground, specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of section 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

SECTION 282—SECTION REVISED

Derived from title 35, U. S. C., 1946 ed., § 69, (R. S. 4920, amended (1) Mar. 3, 1897, ch. 391, § 2, 29 Stat. 692, (2) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The first paragraph declares the existing presumption of validity of patents.

The five defenses named in R. S. 4920 are omitted and replaced by a broader paragraph specifying defenses in general terms.

The third paragraph, relating to notice of prior patents, publications and uses, is based on part of the last paragraph of R. S. 4920 which was superseded by the Federal Rules of Civil Procedure but which is reinstated with modifications.

[As passed by the House, item (1) read "Noninfringement or absence of liability for infringement," which was amended by the Senate].

R. S. 4920. In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than one year prior to his application for a patent therefor; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it has been in public use or on sale in this country for more than one year before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

* * * * *

TIME OF TAKING EFFECT.

Sec. 4 (a) This Act shall take effect January 1, 1953 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

* * * * *

REPEAL OF PRIOR STATUTES

Sec. 5: The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1953.

THE ESTATE STOVE COMPANY and NOMA ELECTRIC CORPORATION (a Maryland Corporation), and NOMA ELECTRIC CORPORATION (a New York Corporation), Petitioners,		No. 155
vs.		
GENERAL MOTORS CORPORATION and GENERAL MOTORS SALES CORPORATION, Respondents.		

RESPONDENTS' BRIEF OPPOSING PETITION FOR WRIT OF CERTIORARI.

This case is simply a private patent controversy between the parties. The Court of Appeals for the Sixth Circuit, called the "Court below" herein, merely reversed the District Court on a ground *not* decided by the District Court, namely, lack of invention because all of the elements of each of the patents in suit were old and in the alleged combinations did not perform additional and different functions than they did out of the combinations (R. IV—Volume number—pp. 27-28, 36-37 of First Opinion).* The Court below further found, in each of its opinions, that the Bradbury claims were invalid for indefiniteness (R. IV pp. 22, 24; 89 to 91); and also that defendants followed the prior art (R. IV pp. 28; 91). These findings are not raised nor disputed in the Petition.

There is no diversity of decision with any other Court. The facts, as found by the Court below, are not challenged in the petition.

* The Court adhered to its conclusion in its second opinion, that is, the "Order Denying Petition for Rehearing" (R. IV pp. 92, 93).

Petitioners bottom their petition (pp. 4, 5) on two legal propositions, to-wit: (1) that the New Patent Act applies to this case and (2) that the Act sets up a new test of invention.

These propositions were found to be without merit by the Court below in its second opinion. Petitioners cite no case in conflict with the reasons and conclusions of that Court (R. IV pp. 87 to 90). There is none. As we shall show, other Courts of Appeals, the Court of Customs and Patent Appeals, the Court of Claims and several District Courts are in complete accord with such reasons and conclusions.

Petitioners contend (pp. 5, 15) that the Court below applied the subjective "Flash of Genius" test. *Nothing* in its decisions supports this contention.

Petitioners' so-called "Statement of the Case" (pp. 8, 9 and 10) is as incomplete, misleading and inaccurate, as it is pointless on the issues raised in the Petition. It can be dismissed from consideration without further ado.

THE NEW PATENT ACT DOES NOT APPLY.

As pointed out by the Court below (R. IV p. 85, 2nd Opinion):

> "The new codified Patent Act became effective January 1, 1953. The appeal in this case was perfected long before that time, the case having been orally argued before this court several [8-½] months before the new statute went into effect. However, the decision of this court was not announced until thirteen days after the effective date of the Act." (Brackets ours throughout.)

The case was tried in the Spring of 1947 by the District Court. Its "Opinion on Issue of Validity" was rendered April 12, 1948 (R. II 846).

The Court below held (R. IV p. 92):

> "We are of the opinion that the *new Act does not apply to our adjudication of this case.* In *Texas-Miller Hat Corp. et al* v. *Switzer Bros. Inc.* et al., 201 F. 2d 824 (C.A. 5), where the court of appeals reversed the district court's holding of validity and infringement in a case tried before the effective date of the new Act, it was said:
>
> > 'The newly enacted Patent Codification Act did not go into effect until Jan. 1, 1953, and has *no* application to the present case. See last sentence of the new act, Section 293, Sec. 5, which preserved existing rights under repealed sections.' " *
> > (Italics ours throughout unless otherwise noted).

The Court of Appeals for the First Circuit also expressly said in *Carlson & Sullivan Inc.* v. *Bigelow & Dowse Co.*, 202 F. 2d 654, 655-6 (March 19, 1953):

> "*Certainly* it would be unlikely that Congress would intend any change it might make in the test for patentable invention to apply to cases tried and decided in the district court before the statute effecting the change was enacted, and which were pending on appeal when the statute went into effect. And *it seems clear that Congress had no such intention,* for in §4(e) of the statute enacting Title 35, United States Code into law, 66 Stat. 792, 815, it is provided:
>
> > [Sec. 4(e)] 'Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction.'

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* Sec. 5 reads: "The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal."

> *This provision is decisive*, and the appellant can draw *no comfort* from the last sentence of (a) of § 4 id., * * *, wherein the Act is made to apply to unexpired patents granted prior to the effective date of the Act. *The reason for this is that the sentence referred to makes Title 35 applicable to unexpired patents only 'except as otherwise provided', and (e) quoted above clearly does provide otherwise with respect to findings on the issue of validity made prior to January 1, 1953.* Thus we find no present occasion to consider what change in the test for patentable invention Congress intended to make by § 103, supra, if, indeed, it intended by that section to make any change at all."

In *Stanley Works* v. *Rockwell Mfg. Co.*, 203 F. 2d 846, 849 (April 13, 1953), the Court of Appeals for the Third Circuit flatly said "the 1952 Patent Act by its terms is inapplicable to this [validity] issue," and then, after quoting Section 4(e), concluded:

> "That statutory language *cannot* be easily misinterpreted. *The decision of the District Court* holding the Tautz patent Claim No. 6 invalid, rendered prior to the effective date of the Act, *is expressly without the scope of the Act.*"

Thus, in addition to the Court of Appeals for the Sixth Circuit, the Courts of Appeals for the First, Third, and Fifth Circuits have held, without doubt, that the Act, under its very provisions, does *not* apply to infringement cases tried before January 1, 1953.* There is complete agreement between circuits.

Petitioners only mention the *Texas-Miller* decision and say that it was "incorrectly decided" (p. 22). *They cite no contrary authority.*

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* *Gage* v. *U. S.*, 96 USPQ 188 (Court of Claims; Feb. 3, 1953) and *Gagnier Fibre Products Co.* v. *Fourslides Co.*, 98 U.S.P.Q. 9 (Dist. Court, E. D. Mich. S. Div. decided June 10, 1953, published July 6, 1953) at [2] on page 11, are to the same effect.

Since the Act does not apply, that alone should warrant denial of the Petition, and hence it should be unnecessary (as in *Carlson & Sullivan, supra*) to consider petitioners' proposition that the Act sets up a new test of invention. Nevertheless, we will show that this second legal proposition of petitioners is also utterly without merit.

NEW ACT CREATED NO NEW TEST OF INVENTION.

Petitioners pitch their proposition that a new test was legislated on only Section 103 and the first paragraph of Section 282 of the new Act. Petitioners ignore the devastating portions of the opinion of the Court below.

Section 282, 1st Paragraph. It reads:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

The Court below said (R. IV p. 87):

> "The Revision Notes in the Appendix to the Report of the [Senate Judiciary] Committee set forth that the new provision of the statute declares the presumption of validity *theretofore* existing" (R. IV p. 87).*

The Reviser's Notes state:

> "The first paragraph declares the *existing* presumption of validity of patents" (R. IV p. 84).

And the House Report states:

> "Section 282 introduces a declaration of the presumption of validity of a patent, *which is now a statement made by courts in decisions* * * *" (R. IV p. 81).

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* Gagnier Fibre Products Co. *supra*, at p. 12, col. 1, 98 U.S.P.Q., likewise holds "that this was the law long before the new act was written * * *."

Section 103.

The Court below said (R. IV pp. 87 to 89) with respect to the first sentence of Section 103*:

> "We fail to see the basis upon which the conclusion can be drawn, as argued by appellee, that the Patent Act of 1952 provides a new test of patentability, in so far as the issue of patentability in the instant case is concerned; and *the legislative history appears to afford no support to appellee's view that a new test as to 'obviousness' has been embodied in the Act.* In this regard, the Senate Committee on the Judiciary, to which the bill to codify the patent law was referred, in its Report, repeating in substance the House Report, sets forth:
>
> > 'Section 103, *for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years,* but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still *not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writings.* Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in Section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a

* §103. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

person skilled in the art, then the subject matter cannot be patented.' * * *."

"The Revision Notes in the Appendix to the Senate Report further state:

'There is no provision corresponding to the first sentence [of Sec. 103] explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and *the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since* at least as early as 1850.'"

"From the foregoing, it would appear that the new Act has done no more in this respect than to adopt the test of so-called 'obviousness' which has, in the past, been enunciated by the courts, and that *it did not provide a new test differing from that which has been generally followed in the adjudication of patent cases.*"

There are fully supporting decisions; *no* contra one.

In *Stanley Works* v. *Rockwell, supra,* the Court of Appeals for the Third Circuit likewise quoted from the Senate Committee's Report and said (at page 849 of 203 F. 2d):

"On its face Section 103 is merely a codification of decisional patent law. The *report* of the Senate Committee on the *Judiciary* (citing publication) *leaves no doubt about this."*

In *New Wrinkle Inc.* v. *Watson, Com'r**, 204 F. 2d 35, 37 (April 7, 1953), the Court of Appeals, District of Columbia, said that the new Act "does not help applicants," and quoted part of the House Committee's Report and also the following statement of Charles J. Zinn, Law Revision Counsel of the House Committee:

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* This case involved the denial of a patent on an application pending January 1, 1953. Section 4(a) of the new Act provides that the Act "shall apply to further proceedings on applications pending on such date" and there is no "saving" clause in the Act as to pending applications.

> "Section 103 is a *restatement* of the rule invalidating patents for lack of invention or lack of patentable novelty *which has long been recognized by the courts and other authorities* but has not before been spelled out in the statute." (1952 U. S. Code Cong. & Adm. News, pp. 2507, 2513)

In Application of O'Keefe, 202 F. 2d 767, 771 (March 11, 1953), which also involved the denial of a patent, the Court of Customs and Patent Appeals quoted from the Senate Committee's Report and held:

> "The Patent Act of 1952, 35 U. S. C. § 103, which took effect January 1, 1953, has apparently *neither raised nor lowered the standard of invention.*"

In *Thys Co.* v. *Oeste,* 111 F. Supp. 665, February 25, 1953, the District Court (N. D. Cal. N. D.) also quoted from the Reviser's Note on Section 103 and held:

> "A careful study of this new patent code, however, *convinces* this Court that Congress has *not* intended to change any of the classical norms by which invention shall be tested" (p. 673).
>
> • • • • •
>
> "It is difficult to perceive how the plaintiffs can gather comfort from either this section or the Reviser's Note thereon. It would seem that *Congress* here has *clearly indicated that it did not intend to lower the standard of invention* which obtained before the new codification—'since at least as early as 1850.' • • •" (p. 674).

In *Gagnier Fibre Products Co. supra,* at p. 11, col. 2, 98 U.S.P.Q., the Court said:

> "That [1st sentence of § 103] has been the case law in the United States for many years."

Thus at least six Courts, including the Court below, have convincingly and unequivocably declared (in four patent in-

fringement cases and two patent application cases) that Section 103 of the new Act did *not* change the *theretofore* test of invention but *merely* codified the decisional patent law!

Petitioners cite no case to the contrary. There is none. All of the eloquence poured into petitioners' exaggerated dissertation (p. 14) as to the dire and "groaning" consequences of this Court's decisions and as to the supposed cure by the new Act comes to naught.

Petitioners' second legal proposition fails as thoroughly as their first. We again submit the petition should be denied.

THE COURT BELOW DID NOT APPLY THE "FLASH OF GENIUS" TEST.

Petitioners' Baseless Fact Premise.

Petitioners would use their untenable legal propositions as a smoke screen to attack this Court's *A & P* decision* as part of a devious plan to obtain another hearing on the merits.** In furtherance of their plan, petitioners wrongfully contend, *ad nauseam*, that the Court below applied the subjective "Flash of Genius" test (pp. 2, 3, 4, 5, 11, 12, 15, 17, 18, 23). The petition is as totally unfounded in fact as it is in law, as we shall now show.

Petitioners pretend that, if the new Act does apply, the

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* *Great Atlantic and Pacific Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147 (1950).

** Such a hearing is not one of the reasons for certiorari stated in Supreme Court Rule 38(5). As Chief Justice Taft said in *Magnum Co.* v. *Coty*, 262 U.S. 159, 163:

> "The jurisdiction [by way of certiorari] was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."

Court below violated the last sentence of Section 103, reading:

> "Patentability shall not be negatived by the manner in which the invention was made."

Petitioners could not, and hence do not refer to any pertinent portions of the decisions below or to the record. Indeed, petitioners do not even attempt to point out the "manner in which" each claimed structure "was made," that is, whether it resulted from long toil and experimentation or from a flash of genius.

Petitioners many times belabor the term "flash of genius," which appears in the *Cuno* decision,* *not* in the *A & P decision.* The Court in *neither* decision below made any mention of "flash of genius" and only *once* cited, without discussion, the (R. IV p. 27) *Cuno* case in which a thermostat was added to a cigar lighter. Here, Bradbury claims a stove with an added thermostat.

The True Facts as to the Test Applied.

What the Court below actually did was (1) explain in considerable detail the structures of the patents in suit (R. IV pp. 4 to 8, 30, 31); (2) carefully scrutinize the claims (R. IV 20, 21); (3) meticulously analyze the prior art, including Estate's prior ranges (R. IV pp. 7 to 25, 31 to 35); (4) quote from and cite several pertinent decisions and (5) conclude on *all* the *documentary, physical* and oral *evidence* and as a matter of law that the claims in suit were invalid because, at the times Bradbury and Kahn and Hake made their alleged inventions, the elements of the claimed combinations were admittedly old and used in various combinations and performed no additional or new

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* *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84.

functions in the claimed combinations than they did out of them (R. IV pp. 27-8, 35 to 38 of the 1st Opinion and pp. 92-3 of 2nd Opinion).

Regarding the pertinent decisions, the Court below first quoted, as appears in the margin below,* from *Lincoln Engineering Co.* v. *Stewart-Warner,* 303 U.S. 545 (R. IV p. 27). That case was decided in 1938, that is three years before the *Cuno* decision, and petitioners say (p. 15) that "the more liberal attitude and more favorable climate of opinion in the courts * * * existed prior to the *Cuno Engineering* decision." Then later (R. IV pp. 36-7), the Court below further discussed the comparable facts and rulings of this Court in *Grinnell Washing Machine Co.* v. *E. E. Johnson Co.,* 247 U.S. 426** and cited *Leonard* v. *Cutler-Hammer Co.,* 168 F. 249, C.C.A. 2, which cases were decided 23 and 32 years "Before Cuno."

The Court below also quoted (R. IV pp. 27, 28) the following passages, among others, from the *A & P* decision:

---

* "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention."

This same passage was quoted with approval by this Court in its *A & P* decision (at p. 151).

** The Court below expressly said, in part, and quoted from the Grinnell decision as follows: "In concluding its opinion, the court expressed itself along *lines that are peculiarly applicable to the instant case,* in stating that the patentee's 'aggregation of elements may be likened to the operation of a number of different machines in a factory by power applied from the same line shaft, each operation contributing its separate part to the production of a given result. So in this instance we think the combination accomplished by (the patentee) fails to show that exercise of invention, producing a novel and useful result from the cooperating action of the elements, which is essential to distinguish patentable combination from an aggregation of old elements so placed by mechanical skill as to do work more rapidly and economically.' "

This *Grinnell* case was also cited by this Court in its 2nd Opinion (R. IV, p. 92).

"The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable * * *."

* * *

"Neither court below has made any finding that old elements which made up this device perform any additional or different function in the combination than they perform out of it. . . . * *"

The Court below pointed out that the District Court in the instant case had likewise made no such finding.

In *Gagnier Products, supra* (98 U.S.P.Q. at 13, Col. 2), the Court discussed and applied the *A & P* case and pointed out that the test of invention, as stated and applied by this Court in the *A & P* case, was not the "flash of genius" test.

The Court below ably summarized in one paragraph of its second opinion (R. IV 93-4), the test which it applied here. The Court first recognized that "combination patents are not to be stricken down" by "subjecting each element to the test of whether it be old." Then it stated, as held by the above quoted-from decisions, that "the combination of old elements must perform a new or different function" or achieve an "unusual and surprising consequence," which it found was not true of the patents in suit. Clearly the Court below did *not* apply the "Flash of Genius" or "subjective" test, though if it had the result would have been the same.

Petitioners Admissions Re A & P

Petitioners urged before the Court below (R. IV p. 71):

"The [*A & P*] decision does *not* state that it changes the law, and there is *no* reason to suppose it was intended to do so." (Main Brief)

"Mere aggregation cannot constitute patentable invention; if there is patentable invention, there cannot be mere aggregation. *That has long been the*

> *established law*—recognized long before the A & P case." (Italics Petitioners') (Reply Brief)

Petitioners now repeatedly harp (p. 17, for example) that Section 103 provides that "the subject matter *as a whole* would have been obvious." But petitioners, in support of their contention that the *A & P* decision did not change the law, quoted the following from that decision:

> "Only when the *whole* in some way exceeds the sum of its parts is the accumulation of old devices patentable." (Main Brief, R. IV 71).

Petitioners should be held to their professions!

The Court below very properly concluded in its second opinion that the principle of the *A & P* case "continues to be the law" (R. IV pp. 93-4).

CONCLUSION.

The new Act does not apply. It sets up no new test of invention. The Court below followed the proper test. Petitioners do not challenge the findings of the Court below that Bradbury's claims are invalid for indefiniteness and that the respondents followed the prior art.

We respectfully urge that the petition be denied.

Respectfully submitted,

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IN THE

Supreme Court of the United States

No. 155

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—v.—

GENERAL MOTORS CORPORATION and GENERAL MOTORS SALES CORPORATION,

Respondents.

PETITIONERS' REPLY BRIEF

MORRIS KIRSCHSTEIN,
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PETITIONERS' REPLY BRIEF

On the two principal grounds of the Petition based upon the new Act, the Respondents state that there is no case in conflict with the reasons and conclusions of the Court below (Res. Br., p. 2). Respondents are in error. As to both grounds there is a case in support of Petitioners' contention and as to both grounds there is a conflict of Court opinion.

I

There is a disagreement among Circuit Courts of Appeal as to the applicability of the new Act in circumstances here presented.

As to the applicability of the new Act, the Third Circuit Court of Appeals has on July 29, 1953, after the filing of the Petition herein, held in *United Mattress Mach. Co.* v. *Handy Button Mach. Co.*, 98 U. S. P. Q. 296, 297 (not otherwise reported):

"Since the district court opinion, 108 F. Supp. 899, was rendered after January 1, 1953, although the trial was held before that date, the 1952 Patent Act governs this case. See Sec. 4 of the Act, supra Note 1, 66 Stat. 815 and Stanley Works v. Rockwell Mfg. Co., 203 F. 2d 846, 849 (3 Cir. 1953)."

There is thus a disagreement between the Third Circuit Court of Appeals on the one hand, and on the other hand, the Fifth Circuit Court of Appeals (*Texas-Miller Hat Corp.* v. *Switzer Bros., Inc.,* 201 F. 2d 824) and the Sixth Circuit Court of Appeals in this case which merely followed the *Texas-Miller* case (see Pet. Main Br., p. 22). The conflict is a sharp and important one clearly requiring resolution by this Court. The Third Circuit Court of Appeals agrees with Petitioners' basic contention that the new Act applies to all unexpired patents granted prior to January 1, 1953 and with Petitioners' basic contention that there is no constitutional guarantee against a change in climate of opinion (Pet. Main Br., pp. 21-22).

II

There is disagreement as to whether the test of invention has been changed by the new Act.

In *Gagnier Fibre Products Co.* v. *Fourslides, Inc.,* 112 F. Supp. 926, the District Court for the Eastern District of Michigan (Southern Division) held Sec. 103 did change the test of invention of the *Cuno Engineering* and *Great A. & P.* cases, saying:

"Attention is also directed to this clause in Section 103:

> 'Patentability shall not be negatived by the manner in which the invention was made.'

This, we must admit is new, because in a Senate report that clause is clarified and it does change some phases of case law. As stated in the report this particular wording was used to provide the Patent Examiners and the Courts with a yardstick that in considering the patentability of any article from January 1, 1953 on, it would be immaterial whether the invention

> 'resulted from long toil and experimentation or from a flash of genius.'

This wording officially not only rejects the 'flash of genius' test of Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84, 62 S. Ct. 37, 86 L. Ed. 58, which this court necessarily followed in Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162, but it goes farther.

Today one may have a patent if he just 'stumbled' upon his invention or it might even have been the result of an accident. But the 'flash of genius' is not claimed in this case" (p. 929).

It is significant that the District Court of the Sixth Circuit rendered its decision in the *Gagnier* case on June 10, 1953 after the Sixth Circuit Court of Appeals had rendered its second opinion in the case at bar on April 17, 1953 holding to the contrary that the new Act "did not provide a new test differing from that which has been generally followed in the adjudication of patent cases" (R. IV, p. 89). That a District Court disagrees with its own Circuit Court of Appeals bespeaks strongly indeed a serious uncertainty as to how the Courts should construe the new Act. The conflict is sharp and must be resolved by this Court.

III

On the merits respondents beg the question.

Respondents argue that the Sixth Circuit Court of Appeals correctly decided this case upon the authority of the *A. & P.* case and that the Court below did not specifically refer to the "flash of genius" criterion of the *Cuno Engineering* case. What respondents fail to recognize is that both generally, and specifically as to claims for combination of old elements, the *A. & P.* case laid down an even more strict standard of invention than the *Cuno Engineering* case and the Courts have so construed the *A. & P.* decision. This is evidenced by a host of decisions that followed fast upon the heels of the *A. & P.* decision. See for example: *Vapor Blast Mfg. Co.* v. *Pangborn Corporation,* 186 F. 2d 230, 236 CA 4. Moreover, both in the majority and minority concurring opinions, the *A. & P.* case made specific reference to the *Cuno Engineering* case.

Particularly with reference to new combinations of old elements, the *A. & P.* decision has been construed as almost a complete barrier to the patentability of such combinations because in that case this Court admonished the Federal Courts as to the "improbability" (340 U. S. p. 152) of such combinations being patentable. In *Pennsylvania Crusher Co.* v. *Bethlehem Steel Co.,* 193 F. 2d 445, the Third Circuit Court of Appeals said:

> "Even if we were to accept the thesis urged upon us by Pennsylvania that the Battey machine is a new combination of old elements, we do not think it can withstand the strict test set forth by the Supreme Court in

> Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 1950, 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162. That decision directs us to 'scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements" (p. 450).

See also *Smith* v. *Dravo Corp.*, 203 F. 2d 369, 380, CA 7; and *Application of Franz*, 190 F. 2d 86, 89, CCPA.

It is Petitioners' contention that the provision in Section 103 requiring that the combination be obvious "as a whole" was directed against this more severe test of the *A. & P.* case. This point is completely by-passed by Respondents, although it is clear from the decision of the Sixth Circuit Court of Appeals herein that it too relied upon the severe test of the *A. & P.* case. In its first opinion, that Court said:

> "We are of the opinion that these patents did not partake of the quality of invention. The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147" (R. Vol. IV, p. 36).

And in its second opinion, that Court said:

> "We are, however, of the view that the principle stated in the *Great Atlantic & Pacific Tea Co.* case is not modified by the new Act, but continues to be the law, and is here controlling" (R. Vol. IV, pp. 93-4).

IV

The issue of infringement was not passed upon by the Court below nor were all the declared claims of the patents in suit characterized as defective for indefiniteness.

The Court below made it clear that it did not pass upon the question of infringement:

> ". . . we are of the opinion that since we found that the patent was clearly invalid it was unnecessary to pass upon the question of infringement" (R. Vol. IV, p. 91).

The criticism of indefiniteness was directed by the Court below only to the Bradbury patent, the only patent the claims of which relate to balanced heat (R. Vol. IV, pp. 22, 23 and 91).

The reference to indefiniteness is mere *obiter dictum*; for the Court below clearly held the patents invalid for want of invention only. The concluding paragraph of the first opinion reads:

> "In accordance with our conclusions, the patent claims sued upon are invalid *for want of invention*; the judgment is reversed; and the case is remanded with directions to dismiss the complaint" (R. Vol. IV, p. 38) (italics supplied).

CONCLUSION

This petition clearly presents for consideration two basic and important points with regard to the new Act upon which the Courts of the land are in disagreement. The intervention of this Court is necessary to instruct the lower Courts as to the application and interpretation of the new Act.

For the reasons given in the Petition for the Writ and brief accompanying same and this Reply Brief, it is respectfully urged that the Petition should be granted.

Respectfully submitted,

MORRIS KIRSCHSTEIN,
Counsel for Petitioners.

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SUPPLEMENT TO PETITIONERS' REPLY BRIEF

MORRIS KIRSCHSTEIN,
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SUPPLEMENT TO PETITIONERS' REPLY BRIEF

Petitioners respectfully call this Court's attention to *Jeoffroy Mfg., Inc., et al.* v. *Graham, et al.*, 98 USPQ 424 (not otherwise reported), a decision by the Fifth Circuit Court of Appeals published September 28, 1953, which expressly recognizes that the *A & P* case "has enunciated a more strict test of invention than existed theretofore" with relation to claims for combinations of old elements (see Petitioners' Reply Brief, pp. 4-5). In this recent case the Fifth Circuit Court of Appeals said:

> "Though we are constrained to agree with appellants and the District Court that the Supreme Court in the A & P Tea Co. case, supra, has enunciated a more strict test of invention than existed theretofore, we think the fact that some of the elements in Graham were admittedly known to the prior art still would not preclude

its validity, or negative any invention therein, so long as the Graham combination produces a new and useful result in a substantially different way. See E-I-M Co., Inc. v. Philadelphia Gear Works, Inc., No. 14,247, ms., decided June 12, 1953 (97 USPQ 508); Robertson Rock Bit Co. v. Hughes Tool Co., 5th Cir., 176 F. 2d 783, 790-791 (82 USPQ 339, 345-346). We think the basic fallacy of appellants' position as to the lack of invention in Graham lies in their attempt to show anticipation by separating the entire combination into its component elements and, in the light of hindsight, to expose them piecemeal as already known to the agricultural art." (pp. 427-8)

Respectfully submitted,

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Respondents.

RESPONDENTS' REPLY BRIEF

Petitioners' Reply Brief is of such unwarranted and distorted character that we are constrained to reply so that this Court cannot be misled.

I

"There is" NO "disagreement among the Circuit Courts of Appeals as to the applicability" or inapplicability "of the new Act in circumstances here presented."

We have quoted petitioners' first heading or proposition, with unquoted inserts.

The "circumstances here presented" are *not* the same as those presented in the *United Mattress* case (C.A. 3rd)* as petitioners pretend. The Court below in the instant case pointed out that the District Court had decided the case *before* January 1st, 1953, the effective date of the Act, and concluded:

* *United Mattress Mach. Co.* v. *Handy Button Mach. Co.* 98 USPQ 296.

> "We are of the opinion that the new act does not apply to our adjudication of this case" (R. IV 92).

The Third Circuit Court of Appeals said in the *United Mattress* case (p. 297) that the new act governed that case

> "Since the district court opinion 108 F. Supp. 899 was rendered *after* January 1st, 1953 * *" (Emphasis ours)

The Court then cited its earlier decision in *Stanley Works* v. *Rockwell Mfg. Co.*, 203 F.2d 846, 849, in which it held that the act did *not* apply because the District Court's decision was "rendered *prior* to the effective date of the act."*

Petitioners obviously assert in sheer desperation, (Br. p. 4) that

> "the Third Circuit Court of Appeals agrees with Petitioners' basic contention that the new Act applies to all unexpired patents granted prior to January 1, 1953 * * *".

Petitioners' first "basic contention" for its Petition being founded on fiction, the Petition is obviously without merit.

II

"There is" NO "disagreement as to whether the test of invention" applicable here "has been changed by the new Act."

We have quoted petitioners' second heading or proposition, with unquoted inserts.

---

* We quoted more fully from the *Stanley Works* decision on page 4 of our main brief here. We also quoted from or cited on pages 3 and 4 from uniform decisions of the 1st and 5th Circuit Courts of Appeals, the Court of Claims and the District Court, E. D. Michigan in *Gagnier Fibre Products Co.* v. *Fourslides Co.*, 98 USPQ 9.

Petitioners' contention that the District Court in the *Gagnier Fibre* case held that §103 of the new Act changed the test of invention of the *A & P* case and that that District Court disagreed with the decision of "its own Court of Appeals" in the instant case is likewise spurious.

Petitioners base (see Br. p. 3) their contentions on what that District Court said about the second sentence of §103 reading "Patentability shall not be negatived by the manner in which the invention was made". That Court said, however, "But the 'flash of genuis' is not claimed in this case." (p. 929). Petitioners *never* claimed it here. The Court of Appeals made *no* reference to it, but it did apply the age old test of invention, quoting from and citing supporting cases going back to 1909 (See pp. 10 to 12 of our own main brief here).

The Court of Appeals, like seven other Courts*, found, after reviewing its legislative history that the first sentence of §103 did not change the age old test of invention re obviousness (See pp. 5 to 9 of our main brief). In complete agreement, the District Court in the *Gagnier Fibre* case quoted the first sentence and flatly said:

> "That has been the case law in the United States for years. (Citing cases).
>
> In fact this section (103) of the new act merely stabilized or gave statutory effect to what had been long recognized case law." (98 USPQ 11, 12).

This Court in its *A & P* decision did not mention "flash of genius". It merely applied the age old test of invention. In fact, petitioners themselves represented before the Court

* Six decisions of the seven other Courts were quoted from on pages 6 to 8 of our main brief here and the seventh case is *Joseph Bancroft & Sons* v. *Brewster Finishing Co.*, 98 USPQ 187, 193, 194 (not otherwise reported) in which the District Court (D.N.J.) quoted and followed the decision of the Court below and the *Stanley Works* decision.

below that the *A & P* decision did not change the law. (See pp. 12, 13 of our main brief here). Indeed, the District Court in the *Gagnier Fibre* case discussed and quoted at length from the *A & P* decision and followed it! There is not the slightest justification for petitioners' assertion that the District Court in the *Gagnier Fibre* case held that § 103 changed the *A & P* test.

Obviously petitioners' second and only other "point", which they say is "basic and important" (p. 7), is as utterly without merit as the first point.

III

Petitioners nebulous Chapter III has been answered above. We note, however, that there have been over 15 patent cases, quoting from or citing the *A & P* case, rendered since January 1, 1953, and all of them follow, and none quarrel with, what Petitioners say is the *A & P* test.

IV

We never asserted that the Court below passed specifically on the question of infringement. We did say (pp. 1, 13 of our main brief here) that in both opinions of that Court, it found that *defendants had followed the prior art.* Significantly, this is not challenged by petitioners.

Petitioners' statement that the Court of Appeals' "reference to indefiniteness is mere *obiter dictum*" cannot be taken seriously. Petitioners themselves asserted in their Petition for Rehearing to the Court of Appeals (R. IV. 20), "*This Court also held the* [Bradbury] *claims invalid for indefiniteness.*" The Court in its rehearing opinion (R. IV. 89, 90, 91), reviewed the facts and law in detail and adhered

to its finding that Bradbury's claims *"were too indefinite to sustain a finding of validity."*

We again respectfully urge that the petition be denied.

Respectfully submitted,

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